

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

AF 3621
#1 R3
8-02-04
mel

In re application of: SUHY, et al. Group Art Unit : 3621
Serial No.: 09/653,735 Examiner: HEWITT II, Calvin L.
Filed: 09/01/2000
For: APPARATUS AND METHOD FOR TRACKING
AND MANAGING PHYSICAL ASSETS

Attorney Docket No.: 65678-0032

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

RECEIVED

JUL 26 2004

GROUP 3600

CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8(a))

I hereby certify that this correspondence is, on the date shown below, being:

☒ deposited with the United States Postal Service
as first class mail, postage prepaid in an envelope addressed
to Mail Stop Appeal Brief - Patents, Commissioner for Patents,
P.O. Box 1450, Alexandria, Virginia 22313-1450.

☐ transmitted by facsimile to the
Patent and Trademark Office to

Date: July 16, 2004

at _____

Wendy A. Balabon

REPLY BRIEF

Honorable Sir:

This is a Reply Brief submitted pursuant to 37 CFR §1.193 in response to the Examiner's Answer dated May 17, 2004 (hereinafter "the Examiner's Answer").

Claims 1-8 and 12-24 are pending in the application and are the subject of this Appeal. Claims 1, 13, and 18 are independent claims. No claims have been allowed. Claims 1-7 and 12-24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,875,430 ("Koether") in view of U.S. Patent No. 6,230,081 ("Albertshofer"). Claim 8 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Koether, Albertshofer, and U.S. Patent No. 6,003,808 ("Nguyen"). In the Brief on Appeal filed February 12, 2004 ("Appeal Brief"), Appellants provided arguments against each of the foregoing rejections.

Among other arguments in the Examiner's Answer, the Examiner stated the following positions:

- (1) That all presently pending claims are obvious over the prior art references cited by the Examiner;
- (2) That the Examiner can reject several of Appellant's claims pursuant to 35 U.S.C. 103(a) without considering all of their limitations by mischaracterizing claim limitations as "conditional;"
- (3) That the Examiner need not provide documentary support for the taking of Official Notice.

ARGUMENT

As explained below, the Examiner's Answer indicates that the Examiner is not correctly stating or applying the legal requirements for a rejection pursuant to 35 U.S.C. 103(a).

I. THE EXAMINER MUST PROVIDE REFERENCES THAT DISCLOSE EACH AND EVERY ELEMENT OF THE APPLICANTS' CLAIMS.

As stated in the Appeal Brief, the Examiner has not satisfied the requirements for establishing a prima facie case of obviousness as required by MPEP §2143, *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991), and *In re Royka*, 490 F.2d 981, 180 USPQ 560, 562 (CCPA 1972). The Final Office Action dated August 12, 2004 (hereinafter the "Final Office Action") fails to cite support in the cited prior art references for every element of Appellant's claims.

The Examiner's rejection of Appellants' claims follows a pattern of generalizing the claim elements to a substantially high level of abstraction, and then citing references that "generally address" the Appellant's claims. This practice was specifically rebuked by the United States Court of Appeals for the Federal Circuit in *In re Thrift*, Case Number 01-1445 (Fed. Cir. August 9, 2002), a decision that prohibits the rejection of claims based on a "very general and broad conclusion" when "cited references do not support each limitation" in a claim. The Examiner's Answer clearly indicates that the holdings in *In re Vaeck*, *In re Royka*, and *In re Thrift* are not being followed by the Examiner.

The Examiner's rejection of Appellant's claims reveals numerous examples of highly "generalized" rejections. The Appellant's claims set forth specific relationships between the

various claim elements that when taken as a whole, comprise useful, novel, and non-obvious system configurations. These relationships and configurations are not being given their proper impact by the Examiner. Moreover, the Examiner continues improperly to take Official Notice (even introducing newly noticed facts in the Examiner's Answer, as detailed below), characterizing certain recited claim limitations as being known in the art without providing support as previously requested by Appellant. The Appeal Brief covers numerous examples of "generalized" rejections that ignore the interrelationships between claim elements, all of which remain un rebutted by Examiner.

A. The cited references do not disclose "at least one operating characteristic of the asset to determine a lease rate for the asset, the lease rate being a variable."

Independent claim 1 recites the limitation of "a sub-system that analyzes said at least one operating characteristic of the asset to determine a lease rate for the asset, the lease rate being a variable". Independent claims 13 and 18 similarly recite determining a lease rate based on at least one operating characteristic. These limitations represent novel features of Appellant's claimed invention. The Examiner concedes that Koether does not teach determining a lease rate and relies on Albertshofer to reject this claim limitation. However, the Examiner's Answer does not surmount Appellants' argument that neither reference teaches determining a variable lease rate based on an asset's operating characteristics. Similarly, the Examiner's Answer fails to surmount Appellant's argument that the references do not provide any motivation to modify the cited art to teach a variable lease rate, even if Albertshofer did teach the limitation. (See Appeal Brief, pages 10-11.)

In the Appeal Brief (pages 10-11), Appellants argued that the Examiner failed to establish a *prima facie* case of obviousness against the independent claims because Albertshofer does not teach determining a variable lease rate based on an operating characteristic. Rather, Albertshofer teaches calculating a *total lease amount* as a function of asset usage (col. 2, lines 36-38). The asset usage in Albertshofer may arguably be variable, but there is no teaching of a variable lease rate being a variable used to calculate the total lease amount.

The Examiner's Answer (page 9), relying on a dictionary definition of "rate", states simply that the lease rate of Albertshofer is variable because Albertshofer's *total lease amount* depends on usage. The Examiner's arguments continue to ignore the significant distinction between a constant rate and a rate that requires an analysis of at least one

operating characteristic of the asset, making it a variable. As stated in Appellants' Appeal Brief (page 11), "[i]f the Examiner intends to argue that the lease price in Albertshofer is an 'amount...measured per unit of something else' or 'an amount of payment or charge based on another amount,' Appellants agree inasmuch as Albertshofer teaches that the lease price is based on usage charges and the rate is a constant value multiplied by the usage to give the total lease amount." However, Albertshofer does not teach determining a lease rate that is a variable based on an operating characteristic. Rather, Albertshofer is limited to teaching a constant rate that can be used with a variable usage amount to calculate a total lease price. The arguments presented in the Examiner's Answer do not overcome the fact that Albertshofer does not teach determining a lease rate that is a variable or based on an operating characteristic.

Accordingly, the Board is respectfully requested to overturn the Examiner's rejections of independent claims 1, 13, 18, and their dependent claims (claims 2-8, 12, 14-17, and 19-24).

B. Contrary to the assertions of the Examiner, the cited prior art references fail to disclose the claim limitation of "maintenance information affecting said lease rate."

Claim 7 recites the claim limitation of "maintenance information affecting said lease rate." Claim 18 recites "an asset owner establishing said lease rate and analyzing said maintenance information as a factor in setting said lease rate." As Appellants previously argued (Appeal Brief pages 12-13; July 14, 2003 response, pages 11-12), the prior art of record does not teach "maintenance information affecting said lease rate." The Examiner failed to respond to this argument during prosecution. For the first time, the Examiner's Answer attempts to introduce support for the assertion that Albertshofer teaches simply maintenance information. However, the Examiner's arguments are both too late and legally insufficient to support a *prima facie* case of obviousness.

On page 10 of the Examiner's Answer, the Examiner for the first time generalizes the claim limitation of "maintenance information affecting said lease rate" to an unreasonably high level of abstraction, asserting that Albertshofer discusses "wear and tear" and "usage". The Examiner then asserts that Albertshofer's teachings of "usage" read on the claimed maintenance information because "usage" is "related" to maintenance information. This assertion is simply unsupported and unjustified. "Usage" and "maintenance" are plainly different concepts. Indeed, Appellants' Specification makes clear that information related to

asset usage and maintenance are two different things. (Page 2, lines 16-26; page 3, line 27 – page 4, line 5.) Maintenance may or may not be related to usage inasmuch as it may be performed if “a sufficient period of time or usage has elapsed as to trigger the performance of periodic routine maintenance for that asset.” (Page 13, lines 16-18.) Clearly, according to both common sense and Appellants’ Specification, the Examiner has improperly conflated maintenance information with information relating to asset usage information.

Further, even assuming that Albertshofer’s teachings of “usage” are somehow related to maintenance information, the Examiner still has not met the burden of showing that Albertshofer teaches or suggests Appellants’ claim limitation. *See In re Thrift, supra*. Albertshofer does not teach using more than measured usage to calculate an amount due and does not support a *prima facie* case of obviousness against claims 7, 18, and their dependent claims (claims 19-20). Therefore, the Board is respectfully requested to overturn the Examiner’s rejections of these claims.

C. Contrary to the Assertions of the Examiner, the claim limitation of “adjusting said lease rate based on a determination of asset maintenance timeliness” would not have been obvious to one of ordinary skill in the art.

Claim 24 recites the limitation of “adjusting said lease rate based on a determination of asset maintenance timeliness.” Appellants argued in the Appeal Brief (page 13) that the prior art did not teach “asset maintenance timeliness” as a factor in setting the lease rate. Appellants also pointed out the Examiner’s failure to address this claim limitation during prosecution. For the first time, in the Examiner’s Answer, the Examiner attempts to provide support for the rejection of claim 24, but the Examiner’s new argument is both untimely and legally insufficient to establish a *prima facie* case of obviousness.

On page 11 of the Examiner’s Answer, the Examiner introduces a new rationale for rejecting claim 24 – a “customer service rationale.” Specifically, the Examiner asserts that claim 24 would have been obvious to one of ordinary skill desiring to provide customer service by passing savings on to a customer to compensate for an incurred inconvenience. However, this new rationale, even if it were timely, does not plug the holes in the Examiner’s attempts to establish a *prima facie* case of obviousness against claim 24. First, the cited references do not teach the newly introduced customer service rationale; the Examiner is plainly improperly taking Official Notice for the first time in the Examiner’s Answer. Moreover, the prior art of record still does not teach or suggest “asset maintenance timeliness,” let alone “adjusting said lease rate based on a determination of asset maintenance

timeliness.” (Examiner’s Answer, page 11.) Notably, the Examiner’s rationale simply does not mention “asset maintenance timeliness.” Moreover, a desire to provide savings to customers in the name of customer service does not render obvious to those skilled in the art *how* savings are provided.

Thus, the Examiner has failed to cite prior art teaching every one of the limitations of claim 24 as well as teaching or suggesting a motivation to implement the limitations of claim 24. Accordingly, the Examiner still fails to establish a *prima facie* case of obviousness against claim 24, and Appellants respectfully request that the Board overturn the Examiner’s rejection of this claim.

D. Contrary to the assertions of the Examiner, the claim limitation of “said lease rate is lower if timely maintenance is performed and said lease rate is higher if said maintenance is untimely” is not taught in the cited prior art and would not have been obvious to one of ordinary skill in the art.

Claim 21 recites the claim limitations of “said lease rate is lower if timely maintenance is performed and said lease rate is higher if said maintenance is untimely.” In Appellants’ Appeal Brief (page 14), Appellants argued that the prior art did not teach, and that the Final Office Action failed to even consider, these claim limitations. The Examiner’s Brief again attempts to rely on a newly introduced rationale to make a *prima facie* case of obviousness, but the Examiner’s new arguments, even if they were timely, still fail to support a *prima facie* case of obviousness against claim 21.

On page 11 of the Examiner’s Answer, the Examiner relies on the newly introduced “customer service rationale” to reject claim 21. For the same reasons discussed above in relation to claim 24, the Examiner’s attempts to establish a *prima facie* case of obviousness against claim 21 fail. The Examiner’s rationale simply does not mention “asset maintenance timeliness,” let alone increasing or decreasing a lease rate based on the asset maintenance timeliness. Again, a desire to provide savings to customers in the name of customer service – even if the prior art of record taught such a motivation, which it does not – does not make *how* savings are provided obvious to those skilled in the art. The cited references still do not teach or suggest “said lease rate is lower if timely maintenance is performed and said lease rate is higher if said maintenance is untimely,” and the Examiner’s “customer service rationale” does not cure this deficiency. Thus, the Examiner still fails to establish a *prima facie* case of obviousness against claim 21, and Appellants respectfully request that the Board overturn the Examiner’s rejection of this claim.

E. Contrary to the assertions of the Examiner, the claim limitations relating to determining or adjusting a lease rate based on operating characteristics would not have been obvious to one of ordinary skill in the art in light of the cited prior art.

In the Appeal Brief (pages 13-21), Appellants provided claim-specific reasons for the patentability of each of claims 2-6, 15-17, 19, 21, 22, and 24. In response, the Examiner's Answer groups these claims together and does no more than make a general assertion that the claims do not contain allowable subject matter (page 11). Such a sweeping generalization continues the Examiner's pattern of violating the strictures of *In Re Thrift*, discussed above.

Specifically, the Examiner appears to take Official Notice that the concept of adjusting rates is at least as old as the establishment of the Federal Reserve System by the Federal Reserve Act of 1913 (pages 11-12). Firstly, this new taking of Official Notice is untimely. Secondly, even if the Examiner's new assertion is accurate, the Federal Reserve's adjusting of rates is entirely unrelated to Appellant's claim limitations because the claim limitations are directed to determining or adjusting lease rates based on operating characteristics, *e.g.*, asset maintenance timeliness. The adjusting of an interest rate by the Federal Reserve would in no way make Appellant's claim limitations related to adjusting lease rates based on operating characteristics obvious to one of ordinary skill in the art. Significantly, the Examiner fails to provide any explanation as to how the Federal Reserve System would have motivated one of ordinary skill in the art to contemplate the recited claim limitations.

Similarly, the Examiner still fails to provide how a combination of dictionary definitions for "rate" and "surcharge" would motivate one of ordinary skill in the art to contemplate the claim limitations of claims 2-6, 15-17, 19, 21, 22, and 24. The Examiner is again improperly generalizing the claim limitations to an unjustifiably abstract level, as is evidenced by the grouping of claims 2-6, 15-17, 19, 21, 22, and 24 into one group against which dictionary definitions and the existence of the Federal Reserve System are cited. These claims recite distinct limitations that cannot be appropriately generalized as the Examiner has done.

In sum, the Examiner's application of a new rationale to inappropriately generalized claim limitations still falls well short of establishing a *prima facie* case of obviousness against claims 2-6, 15-17, 19, 21, 22, and 24, and therefore the Board is respectfully requested to reverse the Examiner's rejection of these claims.

F. Contrary to the assertions of the Examiner, the cited prior art references do not teach the claim limitation of “a plurality of operating characteristics used to determine said lease rate.”

Claims 5 and 6 recite the limitation of “a plurality of operating characteristics used to determine said lease rate.” Appellants argued in the Appeal Brief (page 21) that the prior art of record failed to teach this claim limitation. In the Examiner’s Answer (page 13), the Examiner asserts that Albertshofer teaches deriving a lease rate from usage, wear and tear, capacity and scope of usage, operating parameters, time, and distance traveled. Although Albertshofer may arguably disclose more than one type of data, Albertshofer teaches using only a single attribute, such as usage duration or distance traveled, to determine a total lease amount (not a lease rate). (See Albertshofer, column 2, lines 33-38). Thus, Albertshofer does not teach these limitations of claims 5 and 6, and the Examiner has failed to establish a *prima facie* case of obviousness against these claims. Therefore, the Board is respectfully requested to overturn the Examiner’s rejections of these claims.

G. The cited prior art references do not teach “an asset owner analyzes said maintenance information for a plurality of assets associated with at least one of said asset supplier and said maintenance organization to evaluate its relationship based on overall maintenance performance.”

Claims 8 and 20 recite the claim limitation that “an asset owner analyzes said maintenance information for a plurality of assets associated with at least one of said asset supplier and said maintenance organization to evaluate its relationship based on overall maintenance performance.” The Final Office Action correctly admitted that neither Koether nor Albertshofer taught “analyzing maintenance information to evaluate a relationship based on maintenance performance” (page 6 of Final Office Action). The Final Office Action then asserted that the warranty system of Nguyen taught this limitation.

As Appellants have previously argued (Appeal Brief, page 22), Nguyen fails to teach evaluating a relationship based on an overall performance because Nguyen merely teaches a warranty validation process that determines simply whether a completed maintenance task is under warranty. The Examiner’s Answer fails to rebut Appellant’s arguments. In fact, the Examiner responds to the Appeal Brief by newly asserting that Koether somehow does teach “an asset owner analyzing maintenance information . . . to evaluate its relationship based on overall maintenance performance.” (Examiner’s Answer, page 15.) However, the Examiner fails to provide any reason or support for this new reading of Koether, and Appellants, having

reviewed Koether, find no support for the Examiner's position. Accordingly the Examiner still fails to establish a *prima facie* case of obviousness against claims 8 and 20.

Further, the Final Office Action asserted that Nguyen reads on the claim limitation of evaluating a relationship based on overall maintenance performance. Appellants maintain the argument (Appeal Brief, page 22) that Nguyen's warranty coverage determination is unrelated to this claim limitation. The Examiner has failed to address Appellants' argument; the Examiner's Answer (page 15) merely repeats the assertion that Nguyen's warranty coverage determination reads on this claim limitation evaluating a relationship based on overall maintenance performance. Because determining warranty coverage for an already performed maintenance task is completely unrelated to the claim limitation of evaluating a relationship based on overall maintenance performance, the Examiner still fails to establish a *prima facie* case of obviousness against claims 8 and 20.

The Examiner attempts to cure the deficiencies in the prior art references by again using the Examiner's Answer to introduce new alleged reasons for rejecting Appellants' claims. Specifically, the Examiner introduces the argument that claims 8 and 20 recite non-functional descriptive language that gives no patentable weight to a claim pursuant to MPEP 2106(IV). (Examiner's Answer, page 14.) The Examiner asserts that the claims include limitations directed to people performing functions that cannot alter the functioning of the claimed system (page 14). This new rationale should be discounted because it was introduced for the first time in the Examiner's Answer.

Moreover, all the limitations recited in claims 8 and 20 are functional and provide patentable weight to the claims. Specifically, the Examiner has made no argument undermining the fact that an asset owner analyzing maintenance information for a plurality of assets associated with at least one of said asset supplier, and a maintenance organization evaluating its relationship based on overall maintenance performance, clearly limit the functionality of the claimed system. Additionally, as discussed above, claims 8 and 20 recite other limitations that are not taught or suggested in the prior art references.

Therefore, it is respectfully requested that the Board overturn the rejections of claims 8 and 20.

II. THE EXAMINER HAS INCORRECTLY IGNORED CLAIM LIMITATIONS BY MISCHARACTERIZING THEM AS “CONDITIONAL” LANGUAGE.

In the Final Office Action, the Examiner asserted that claims 2-4, 15-17, 19, 21, and 22 recite conditional language that can be ignored for purposes of patentability (page 3 of the Final Office Action). These claims all recite adjusting a lease rate if certain conditions are met. In the Appeal Brief (page 15), Appellants argued that the Examiner must consider all limitations of these claims, some limitations of which the Examiner mischaracterized as conditional in nature. These claim limitations are on their face unconditional process limitations. Simply because the claims recite performing steps depending on the result of a test does not mean that the claims recite conditional limitations. Appellant respectfully submits that the Examiner’s basis for ignoring these claim limitations is based on a misinterpretation of the claims and applicable legal precedent.

On page 12 of the Examiner’s Answer, the Examiner cites MPEP 2106(II)(C) as support for the proposition that he need not consider certain claim elements recited in claims 2-4, 15-17, 19, 21, and 22 because the elements recite conditional language. However, these claims recites not limitations that are conditional, but rather recite testing for particular conditions and then executing steps if the conditions are satisfied. Claims 2-4, 15-17, 19, 21, and 22 include limitations related to the lease rate including a minimum charge if said operating characteristic is below a pre-determined threshold and/or a surcharge if said operating characteristic is above a pre-determined threshold.¹ Thus, testing whether an operating characteristic is below or above a pre-determined threshold is not an optional limitation because there is not an alternative to performing this test. Performance of the test is not conditioned on any event; it must be performed for the claim limitations to be met. Thus, the Examiner has improperly characterized at least the “testing” claim elements as conditional.

¹ Specifically, claims 2 and 4 recite, “said lease rate includes a minimum charge if said operating characteristic is below a pre-determined threshold.” Similarly, claims 15 and 17 recite “charging a minimum lease rate when said asset utilization is below a pre-determined threshold.” Claims 3 and 4 recite “said lease rate includes a surcharge if said operating characteristic is above a pre-determined threshold.” Similarly, claims 16 and 17 recite “charging a surcharge when said asset utilization exceeds a pre-determined threshold.” Claim 19 recites “said lease rate includes a minimum charge if said operating characteristic is below a pre-determined threshold or a surcharge if said operating characteristic is above a pre-determined threshold.” Claim 21 recites “said lease rate is lower if timely maintenance is performed and said lease rate is higher if said maintenance is untimely.” Claim 22 recites “a minimum payment that has to be made if measurement of said operating characteristic is below a pre-determined minimum threshold; a usage based-payment if measurement of said operating characteristic is above said pre-determined minimum threshold and below a pre-determined maximum threshold; a penalty payment or surcharge if measurement of said operating characteristic is higher than said pre-determined maximum threshold.”

For the first time during prosecution, the Examiner has suggested how Appellants' claim limitations could be rewritten to be in a form that the Examiner considers to be "unconditional". On page 13 of the Examiner's Answer, the Examiner suggests that using the phrase "based on" as opposed to the word "if" would make the claim elements unconditional. Appellants respectfully suggest that the Examiner has in effect conceded the patentability of Appellants' claims, because if the prior art does not teach performing an action *based on* timely performance of maintenance then plainly it does not teach performing that action *if* maintenance is timely performed.

Further, the Examiner asserts that *Altiris, Inc. v. Symantec Corp.*, 318 F.3d, 1363, 1370, 65 USPQ2d 1865, 1870 (Fed. Cir. 2003) is inapplicable because it focuses on the issues of how much weight to give a preamble of a claim and how to correctly construe the order or sequence of claim limitations (Examiner's Answer, page 13). While *Altiris* addressed the issue of the order of a sequence of process steps, it also shows that patentable weight was given to a testing step and a process step that was executed if the test was satisfied. The claim at issue in *Altiris* (claim 1) recites the step of testing for automation boot sequence data and transferring control of a computer system to automation code, *if* the testing indicates an automation boot sequence. *Id.* at 1868. Thus, *Altiris* is relevant to this appeal at least because claim 1 of the patent at issue in *Altiris* recited conditional steps that are performed if a test condition is satisfied. The Court gave weight to these claim limitations in its analysis of the sequence of method steps. Contrary to the Examiner's assertion that Appellants' claims are devoid of any "testing," Appellants' claim limitations clearly contain a "testing" step in reciting a test of whether an operating characteristic is above or below a pre-defined threshold.

For at least the foregoing reasons, the Examiner is required to consider all the claim elements of claims 2-4, 15-17, 19, 21, and 22. Because the Examiner has not done so, and because the prior art of record does not teach all of the limitations of these claims, the Examiner has failed to establish a *prima facie* case of obviousness against these claims 2-4, 15-17, 19, 21, and 22, and the Board is therefore respectfully requested to direct their allowance.

III. THERE IS NO PROPER MOTIVATION TO COMBINE THE REFERENCES CITED BY THE EXAMINER.

A. There is no motivation to combine Koether and Albertshofer to teach claims 1, 13, and 18.

As noted above, independent claim 1 recites the limitation of “a sub-system that analyzes said at least one operating characteristic of the asset to determine a lease rate for the asset, the lease rate being a variable”. Independent claims 13 and 18 recite the same concept of determining a lease rate based on at least one operating characteristic. In the Appeal Brief (pages 11-12), Appellants argued that the Examiner had failed to establish a *prima facie* case of obviousness against independent claims 1, 13, and 18 because he did not provide any motivation to combine Koether and Albertshofer as required by MPEP § 2143 and *In re Linter*, 458 F.2d 1013, 173 USPQ 560, 562 (CCPA 1972). The Examiner’s Answer fails to surmount this argument.

On pages 9-10 of the Examiner’s Answer, the Examiner introduces new alleged support for his combination of Koether and Albertshofer. The Examiner asserts that it would have been obvious to one of ordinary skill in the art of providing equipment for lease or rent to look at the Albertshofer reference for a teaching of how to accurately monitor the use of a rented or leased item. Even if the Examiner’s new reasoning is not discounted for its late introduction, the Examiner’s assertion still fails to state a proper motivation to combine the references.

Assuming for the sake of argument that the Examiner’s assumption that one of ordinary skill in the art of providing equipment for lease or rent would be skilled in managing commercial or industrial kitchens, the Examiner still provides no explanation as to why one of ordinary skill in managing kitchens would have been motivated by the cited references to analyze an operating characteristic of an asset to determine a lease rate for the asset. The Examiner merely states that one of ordinary skill would look to the Albertshofer reference for a teaching of how to *monitor* the use of leased items. The Examiner makes no mention of a motivation in the cited references for determining a lease rate variable based on an operating characteristic.

Therefore, the Examiner has failed to establish a *prima facie* case of obviousness against claims 1, 13, 18, and their dependent claims (claims 2-8, 12, 14-17, and 19-24). Appellants respectfully request the Board to overturn the Examiner’s rejection of these claims.

B. There is no motivation to combine Nguyen, Koether, and Albertshofer to read on the limitations of claims 8 and 20.

As noted above, claims 8 and 20 recite the claim limitation that “an asset owner analyzes said maintenance information for a plurality of assets associated with at least one of said asset supplier and said maintenance organization to evaluate its relationship based on overall maintenance performance.” The Appeal Brief further presented the argument that the Final Office Action fails to provide any motivation for one of ordinary skill in the art to combine Nguyen, Koether, and Albertshofer to read on the limitations of claims 8 and 20 because contrary to the assertions of the Examiner, none of these references reaches recalling or re-engineering products based on warranty claims (page 23). The Examiner’s Answer does not address this argument and does not provide any motivation to combine the references. Therefore, the Examiner still fails to establish a *prima facie* case of obviousness against claims 8 and 20 because no motivation has ever been given for one skilled in the art to combine Nguyen, Koether, and Albertshofer. Therefore, it is respectfully requested that the Board overturn the rejections of claims 8 and 20.

IV. THE EXAMINER’S FAILURE TO PROVIDE DOCUMENTARY SUPPORT FOR THE TAKING OF OFFICIAL NOTICE WHEN REQUESTED BY APPLICANT REQUIRES REVERSAL OF THE EXAMINER’S REJECTIONS.

Claims 3 and 4 recite the claim limitation that “said lease rate includes a surcharge if said operating characteristic is below a pre-determined threshold.” Claims 16, 17, and 22 include similar limitations relating to charging a surcharge when asset utilization exceeds and/or falls below a pre-determined threshold. The Examiner relies on Official Notice to reject the claim limitations related to a surcharge (Final Office Action, page 4). In the Appeal Brief (pages 7 and 17-18), Appellants pointed out that the Examiner has failed to respond to the requirement that the Examiner provide documentary evidence of the takings of Official Notice as requested by the Appellant.

In response, the Examiner asserts for the first time in the Examiner’s Answer (page 8) that Appellants have not met an alleged burden of pointing out specific errors in the taking of Official Notice pursuant to MPEP §2144.03. However, the Examiner appears to misunderstand the Office’s burden when Official Notice is taken. MPEP 2144.03 states that “Official notice without documentary evidence to support the Examiner’s conclusion is permissible only in some circumstance” and that “Official notice unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be

well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.” The Examiner’s use of Official Notice here does not meet this standard. That a surcharge (*e.g.*, Examiner’s Answer, page 5) is well-known in the art, particularly when considered in the context of asset utilization or an operating characteristic of an asset, is not capable of instant and unquestionable demonstration as being well-known. The burden remains with the Examiner to either provide documentary support for the taking of Official Notice or to show that the officially noticed assertions are capable of instant and unquestionable demonstration as being well-known.

For at least the foregoing reasons it is respectfully requested that the Board overturn the rejections of claims 3-4, 16-17, and 22.

CONCLUSION

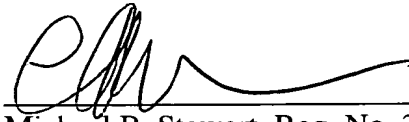
Appellants respectfully submit that all of the appealed claims in this application are patentable for at least the reasons stated above and request that the Board of Patent Appeals and Interferences overrule the Examiner and direct allowance of the rejected claims.

This brief is submitted in triplicate. It is believed that no fees are due with respect to this paper. However, if any fees are found to be required in connection with the filing of this paper, permission is given to charge account number 18-0013 in the name of Rader, Fishman and Grauer PLLC.

Respectfully submitted,

Date: July 16, 2004

By:



Michael B. Stewart, Reg. No. 36,018
Charles A. Bieneman, Reg. No. 51,472
Rader, Fishman and Grauer PLLC
39533 Woodward Avenue, Suite 140
Bloomfield Hills, Michigan 48304
(248) 594-0633
Attorneys for Appellants
Customer No.: 010291